

S/N 09/672,523

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kuriacose Joseph et al.

Examiner: Yogesh Garg

Serial No.: 09/672,523

Group Art Unit: 3625

Filed: September 27, 2000

Docket No.: 2050.001US3

Customer No.: 44367

Confirmation No.: 2175

Title: **METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM**

PETITION UNDER § 1.181(A)(3) FOR THE EXERCISE OF SUPERVISORY AUTHORITY

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicants hereby petition pursuant to 37 CFR § 1.181 for the Director to exercise supervisory authority, and to grant the relief sought below.

Relief Sought

Applicants respectfully request the exercise of supervisory authority to provide guidance to the identified Group to correct what are believed to be incorrect interpretations in the Group regarding 35 USC § 251 and MPEP § 1412 addressing the requirements of that statute, and specifically the inapplicability of the prohibition against recapture in the circumstance presented in the present application, wherein claims have been submitted for an invention not claimed the original patent; and further request a determination that the pending claims are not barred under 35 USC § 251 by the prohibition against recapture.

Background Facts

The present application has experienced an arduous course of prosecution, including two Pre-Appeal Reviews and two RCE's. The issues requiring review and forming the basis of this request for supervisory authority are primarily found in the two most recent rejections, although the rejection on recapture under § 251 originally appeared in 2003. The summarized facts below are provided to assist the Petitions Examiner, however, these most recent (and pertinent) rejections are addressed in paragraphs 7-9 below.

(1) As noted in the caption, the present application was filed September 27, 2000, as a Reissue of U.S. patent no. 5,819,034, to address an invention not claimed in the parent application.

(2) The previously-unclaimed invention addressed in the present reissue application is a method and system that, stated generally, facilitates presenting of data about an item being offered for sale to a user, and in response to a single action by the user, performs certain steps in generating an order for the item. Independent claims 10, 28, 260, and their respective dependent claims are drawn to this previously unclaimed invention. The claims as issued in the parent patent are set forth in Appendix A to this Petition; and the currently pending claims in the present application are set forth in Appendix B.

(3) The issue of recapture was brought up in the Office Action of July 09, 2003, when all of then-pending claims 10, 11, 13-29, 31-39, 41-43, 45-59, 61-67, 246-253, and 260-263 were rejected under 35 USC 251 as "being an improper capture of broadened claimed subject matter surrendered in the application upon which the present reissue application is based."

(4) Following Applicants' arguments submitted with a Pre-Appeal Brief Request on August 4, 2006, (and following the filing of an RCE to submit an IDS), the rejection of claims under 35 U.S.C. § 251 for impermissible recapture was withdrawn in the Office Action mailed on May 03, 2007. In withdrawing the rejection under 35 U.S.C. § 251, the Office Action stated: "because the subject matter of the claims [numbers omitted] is new and not related to the claimed subject matter surrendered in the patent application upon which the present reissue is based."¹

(5) Notwithstanding that determination, a Final Office Action was issued January 6, 2009, which again rejected the claims under 35 U.S.C. § 251 for improper recapture. The legal analysis in the Office Action of the recapture rule relied upon is lengthy, and thus not reproduced here, but a copy of the Office Action of January 6, 2009 is attached as Appendix C. In the analysis, the Office Action stated an exception to the prohibition on recapture in the case of the claiming of an invention that was not previously claimed, but failed to examine that exception relative to the pending claims:

In summary, the recapture rule is avoided if the reissue claim was materially narrowed in other respects compared to its broadening surrendered aspect. A reissue claim is materially narrowed and thus avoids the recapture rule when

¹ A new rejection identified as under § 251 was entered based on an assertion of new matter added by the submitted claims (however, this rejection was also identified as applied under § 112).

limited to aspects of the invention:

- (1) which had not been claimed and thus were overlooked during prosecution of the original patent application; and
- (2) which patentably distinguish over the prior art.²

(6) Applicant's response to the Final Office Action was submitted March 30, 2009, accompanied by an RCE. In the response, Applicant addressed the rejection under § 251, citing MPEP § 1412.02, and identifying that because the reissue claims are claiming additional inventions not originally claimed, the asserted prohibition on recapture is not present.

(7) A subsequent Office Action was issued June 11, 2009, which reiterated the rejection under 35 U.S.C. § 251 for improper recapture, but with somewhat different legal analysis. The analysis asserted to support the rejection under § 251 based on recapture comes down to the single asserted principle that claims for previously unclaimed inventions are permissible only if the original claims are not broadened or deleted by reissue:

The examiner respectfully disagrees [with Applicants' arguments] because reissue claims claiming additional inventions or embodiments not originally claimed are permissible only if any claims amended during prosecution of the original application to obtain the patent are not deleted or broadened by reissue. Since the applicant has canceled all the patented claims which were amended during prosecution of the original application to obtain the patent it is impermissible recapture.³

Applicant notes that the originally issued claims are found in co-pending application, serial no. 09/903,458, and remain pending in that application.

(8) In the response to the Office Action of June 11, 2009, the Applicant filed a pre-appeal brief request for review on October 12, 2009, arguing that the rejection was apparently based on a misunderstanding of the prohibition against recapture, and addressed the impropriety of the rejection in reference to MPEP § 1412.02:

In pertinent part, MPEP § 1412.02 states that *if the reissue claims are claiming additional inventions or embodiments not originally claimed, then recapture is not present*, and that the complete removal of a limitation that was added to obtain the patent is permitted where the replacement limitation provides a separate invention.⁴

² All receptions of the pending claims over prior art have been withdrawn as of the filing date of this Petition.

³ Office Action of June 11, 2009, page 3.

⁴ Pre-Appeal Request for Review, page 3.

(9) The decision on the pre-appeal brief request for review was issued on October 26, 2009, ordering that the prosecution be reopened. However, after the reopening of prosecution, an Office Action was mailed November 18, 2009 that maintained the rejection under § 251 based on improper recapture, stating legal analysis essentially the same as that in the Office Action of June 11, 2009.

(10) Upon information and belief the interpretations underlying these rejections under 35 U.S.C. § 251 originate in the Group.

Pertinent Authorities

35 U.S.C. 251 Reissue of defective patents.

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

MPEP § 1412.02

(Not reproduced here due to length and complex formatting—a copy is attached as Appendix E).

Analysis in Support of the Requested Relief

As noted above, the Office Action mailed on November 18, 2009, rejected claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260 and 262 under 35 U.S.C. § 251 as "being an improper recapture of broadened claimed subject matter surrendered in the application for the

patent upon which the present reissue is based.⁵ Applicants submit that the reasoning in the Office Action, based on selected portions of MPEP 1412.02 is applied inappropriately, resulting in an improper rejection based on recapture under § 251.

The Claims at Issue Are For a Different Invention Than That of The Original Patent

Applicants do not believe that there is any dispute about whether the current claims being drawn to a different invention than are the claims in the original U.S. patent no. 5,819,034 (herein “the ‘034 patent”). For example, Claim 1 of the ‘034 patent is directed to a “distributed computer system” configured to send, receive and execute a distributed computing application that alters an associated video program:

1. A distributed computer system comprising:
 - a source of a data stream providing a series of time division multiplexed packets, ones of which contain auxiliary data that represent a video program, and others of which represent a distributed computing application associated with said video program, and wherein said distributed computing application is repetitively transmitted independent of receiving client computer apparatus during times that said video program is transmitted;
 - a client computer, which includes a packet selector connected to said source for selecting and directing packets containing said auxiliary data representing said video program to a video signal processor and selecting and 50 directing packets containing said associated distributed computing application to a further processor; and
 - said further processor including means to assemble said distributed computing application and execute said distributed computing application to form an interactive video program in which execution of said distributed computing application alters said video program.

The remaining claims in the application are similarly drawn to that general invention.

In contrast, the claims of the present application are directed to methods and systems to facilitate ordering an item, where the order is generated and placed in response to a single action by the user. Claim 10 is illustrative:

10. A method of facilitating ordering an item using a distributed computing system including at least one client and at least one server, the method including:
 - receiving, via a data stream from the server, item data, the item data including information to at least one of show and describe the item via the client and an item identifier to identify the item as currently being

offered for sale;
presenting at least a portion of the item data to a user;
receiving a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data;
responding to the single action by:
 retrieving personal information of the user from a permanent memory in the client, and
 combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and
 transmitting the order for the item from the client.

As noted in the Pertinent Facts section, a rejection based on asserted recapture was previously made in the Office Action of July 9, 2003,⁶ but was later withdrawn in the Office Action of May 03, 2007. In withdrawing the rejection, the (same) Examiner correctly stated the reason for withdrawing the rejection under 35 U.S.C. § 251 was that the subject matter of the claims was “new and not related to the claimed subject matter surrendered in the application for the patent upon which the present reissue is based.” Additionally, none of the rejections has asserted that the current claims are drawn to the same invention as claimed in the ‘034 patent. Thus, there appears to be no dispute that the present claims are drawn to a different invention than were the original claims.

The Current Rejection

After the withdrawal of the § 251 recapture rejection in the Office Action of May 3, 2007, the rejection was re-introduced by the Examiner in the subsequent Office Action of January 6, 2009, and then maintained through the current Office Action. In the current Office Action, the Examiner rejects all pending claims (10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260, and 262) as representing impermissible recapture. The basis for this rejection appears to come down to a position that the current claims represent recapture because the original claims are not present in the application, stating:

The examiner respectfully disagrees [with Applicants’ arguments] because reissue claims claiming additional inventions or embodiments not originally claimed are permissible only if any claims amended during prosecution of the original application to obtain the patent are not deleted or broadened by reissue. *Since the*

⁶Office Action mailed on July 9, 2003, page 2.

applicant has canceled all the patented claims which were amended during prosecution of the original application to obtain the patent it is impermissible recapture.⁷

...

As it can be seen from the above MPEP 1412.02 C that overlooked aspects can be claimed in a reissue application but the claims that were amended and narrowed to obtain patent in the original application cannot be deleted. *In the instant reissue application the applicant has deleted the claims that were amended and narrowed to obtain patent in the original application and hence there is impermissible recapture.⁸*

Thus, the Office Action clearly indicates that but for the absence of the original patented claims in this reissue application, no recapture would be considered to exist. Applicants respectfully submit, however, that the absence or presence of the original claims in a reissue application has no bearing on whether claims for a different invention may be submitted (as is done here); and the presence, or absence, of such original claims is not a touchstone test as the Office Action tacitly asserts.

As previously noted by Applicants (in the response filed March 30, 2009 and also in the pre-appeal brief request for review on October 12, 2009), the recapture rule and the scenarios under which the recapture rule bars reissue claims are addressed in MPEP § 1412.02 titled "Recapture of Canceled Subject Matter." MPEP § 1412.02 (I)(C) is clear in identifying a recapture analysis, but expressly provides that notwithstanding that stated recapture analysis, there is an exception for claims directed to additional inventions/embodiments not originally claimed:

If, however, the reissue claim(s) are really claiming additional inventions/embodiments/species not originally claimed (i.e., overlooked aspects of the disclosed invention), then recapture will not be present.⁹

This is exactly the situation presented here (as expressly acknowledged by the Examiner in the Office Action of May 3, 2007). As noted above, there does not appear to be a dispute that

⁷ Office Action of November 18, 2009, page 3 (emphasis added).

⁸ Office Action of November 18, 2009, page 5 (emphasis added).

⁹ MPEP 1412.02 (I)(C).

the present claims are directed to a different invention than that of the original claims.¹⁰

If the position espoused in the Office Action were correct, then a patentee would never be able to file multiple divisional applications from a reissue application to claim different new inventions, as § 101 restrictions on double patenting would preclude the original claims from being present in each such divisional application. Yet such divisional applications are clearly permitted. In fact, the originally issued claims of the patent under reissue here are found within such a divisional reissue application, serial number 09/903,458, filed July 10, 2001. Thus, the position of the Office Action establishes a “Catch-22” situation for Applicants, where the new claims are asserted to be barred by recapture because the original claims are not present; but if the original claims were present, they would necessitate a rejection for § 101 double patenting. Clearly, that cannot be a correct interpretation of the law on recapture, or of the guidance of the MPEP.

What is in accordance with the guidance of MPEP § 1412.02, is that the current claims are broader in some respects than the original claims, but are materially narrower in other previously overlooked aspects—specifically, facilitating ordering of an item by a user in response to a single user action. And that fact should represent an exception of the recapture rules as to the present claims. As stated in MPEP § 1412.02(I)(C), quoting *Hester Industries*:

[T]his principle [i.e., avoidance of the recapture rule], in appropriate cases, may operate to overcome the recapture rule when the reissue claims are materially narrower in other **overlooked aspects** of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects. [*Hester*, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50.] (emphasis in MPEP).

¹⁰ For more discussion on that point, the broadening of the earlier versions of the current claims relative to the ‘034 patent claims in some respects, and the narrowing in others, was addressed by Applicants in the Response to Office Action of July 9, 2003 at pages 15-20 (copy attached as Appendix E).

In summary, the present reissue claims are clearly claiming a previously overlooked invention that is different from that originally claimed, as acknowledged by the Examiner in the Office Action of May 3, 2007. And in that situation, under 35 USC § 251 and the guidance of MPEP § 1412.02, there should be not be a rejection on recapture. Applicants therefore respectfully request that the position rejecting the claims for impermissible recapture be reversed, and that the Group be instructed as to the guidance of the MPEP on recapture.

Conclusion

For the reasons set forth above, Applicants respectfully request granting of the above-requested relief. In accordance with MPEP § 711.03(c) II, Applicants' understanding is that no fee is required for this Petition under 37 CFR § 1.181. However, if it is determined that this Petition needs to be decided under another Rule, or if any other matter requires the payment of any additional fees in order to obtain granting of the above-requested relief, please charge any additional fees, or credit any deficiencies to Deposit Account No. 19-0743.

The Petitions Examiner is invited to contact Applicants' undersigned attorney at 408-278-4052 to discuss any questions that may remain with respect to the present application.

Respectfully Submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402--0938
(512) 628-9324

Date January 18, 2010 By /Elena Dreszer/
Elena B. Dreszer
Reg. No. 55,128

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this
xxxxxxxxxx 18 January 2010

John D. Gustav-Wrathall
Name


Signature